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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,971	03/11/2004	Bernd Loibl	26202.130	4022

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EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/796,971	Applicant(s) LOIBL, BERND	
	Examiner Clark F. Dexter	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/26/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on December 5, 2003. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. The information disclosure statement filed on August 26, 2004 has been received and the references listed thereon have been considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the structure wherein each overlapping end (which includes both ends) of the guide bar having a protective tab as claimed in claim 7; the spring as set forth in claim 10; and the immobilization device including the specific structure thereof as claimed in claims 11-13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

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is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:

On page 7, line 2, "a spring" is unclear as to what it refers, and it is suggested to either add a numeral or --(not shown)-- as appropriate.

Appropriate correction is required.

Claim Objections

5. Claims 1-13 are objected to because of the following informalities:

In claim 1, line 1, "or the like" is not sufficiently clear as to what other types of sheet material are intended thereby; in line 7, it seems that --the-- is missing before each of "bed" and "guide bar", and it should be inserted for clarity.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 1st paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 4 and 11-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 4, the disclosure does not provide sufficient support for the structure to limit the pivoting of the guide bar to 10 degrees and thus does not provide an enabling embodiment therefor.

Regarding claims 11-13, the disclosure does not provide sufficient support for the immobilization device including the specific structure thereof to perform the recited functions and thus does not provide an enabling disclosure therefor.

8. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification and drawings do not provide support for each overlapping end of the guide bar having a downwardly projecting protective tab overlapping the bed. Rather, support is provided for only one protective tab on the guide bar.

Claim Rejections - 35 USC § 112, 2nd paragraph

9. Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the recitations of “end(s)” and “overlap(s)” renders the claim vague and indefinite as to whether one or a plurality of ends are being claimed.

In claim 9, the recitation “wherein without actuation” is vague and indefinite as to what is being set forth (that is, it is not clear as to what structure is being implied by the subject recitation in this particular instance).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 1-4, 6-9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Mori, pn 5,069,097 (hereafter Mori '097).

Mori '097 discloses a cutting unit with every structural limitation of the claimed invention including:

a planar bed (e.g., 53) for supporting the sheet material and a rotary cutting device that has a knife carriage (e.g., 40) displaceable on a guide bar (e.g., 35) and a circular knife (e.g., 26) rotatably mounted thereon, wherein the guide bar is raisable from a lower cutting position into an upper initial position, and lowerable from the latter back into the cutting position, and the gap between bed and guide bar is inaccessible from the ends of the guide bar;

wherein the guide bar is guided in vertically displaceable fashion in the region of its ends;

wherein the guide bar is raisable by 5 to 20 mm (although not limited thereto);

wherein the guide bar is mounted pivotably about a horizontal axis (e.g., at 41) in the region of one end;

wherein the ends of the guide bar overlap the bed;

wherein each overlapping end of the guide bar has a downwardly projecting protective tab (e.g., at 50, 41) overlapping the bed;

wherein the protective tab (e.g. 41) is laterally guided in a slot (e.g., 58) in the bed;

wherein without actuation, the guide bar assumes the cutting position (e.g., as shown in Fig. 3);

wherein the guide bar is retainable in the cutting position at its vertically movable end by means of an immobilization device (e.g., 50, 58), and wherein the immobilization device is embodied as a snap device (e.g., 50 and/or 58) into which the guide bar automatically and disengageably snaps upon movement into the cutting position.

Claim Rejections - 35 USC § 102/103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 13 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mori, pn 5,069,097 (hereafter Mori '097).

Mori '097 discloses a cutting unit with every structural limitation of the claimed invention as described above and further including the snap device having an actuation slider (e.g., 50) with which the snap device is disengageable.

In the alternative, if it is argued that the snap device is not part of the guide bar, and thus Mori '097 does not disclose the snap device having an actuation slider with which the snap device is disengageable, the Examiner respectfully submits that such a configuration would amount to a mere reversal of parts, wherein the recess 58 is provided in the guide bar, and the spring biased hook 50 is provided on the base 53. It is well settled that such a reversal of parts has been held to be an obvious expedient to

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one having ordinary skill in the art and would amount to a mere matter of design choice to one having ordinary skill in the art.

14. Claims 1, 2, 6-8 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by Mori, pn 5,671,647 (hereafter Mori '647) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mori, pn 5,671,647 (hereafter Mori '647) in view of Mori, pn 5,069,097 (hereafter Mori '097).

Mori '647 discloses a cutting unit with every structural limitation of the claimed invention including:

a planar bed (e.g., 14) for supporting the sheet material and a rotary cutting device that has a knife carriage (e.g., 16) displaceable on a guide bar (e.g., 13) and a circular knife (e.g., 20) rotatably mounted thereon, wherein the guide bar is raisable from a lower cutting position into an upper initial position, and lowerable from the latter back into the cutting position, and the gap between bed and guide bar is inaccessible from the ends of the guide bar;

wherein the guide bar is guided in vertically displaceable fashion in the region of its ends;

wherein the ends of the guide bar overlap the bed;

wherein each overlapping end of the guide bar has a downwardly projecting protective tab (e.g., at 15) overlapping the bed;

wherein the protective tab (e.g. 15) is laterally guided in a slot (e.g., see Fig. 1) in the bed; and

wherein without actuation, the guide bar is held in the upper position by means of a spring (e.g., 19).

In the alternative, if it is argued that Mori '647 does not explicitly disclose that the rotary blade is circular, such circular blades/knives are old and well known in the art and provided various well known benefits including efficient operation as well as being inexpensive to manufacture and assemble. Mori '097 discloses one example of such a circular blade/knife. Therefore, it would have been obvious to one having ordinary skill in the art to provide a circular blade/knife on the apparatus of Mori '647 for the well known benefits including those described above.

Claim Rejections - 35 USC § 103

15. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori, pn 5,069,097 (hereafter Mori '097).

Mori '097 discloses a cutting unit with almost every structural limitation of the claimed invention as described above but lacks an explicit disclosure of the guide bar being limited to 10 degrees of pivoting. However, to provide such a limited pivoting action would be the mere discovery of the optimum or workable ranges within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571)272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Clark F. Dexter
Primary Examiner
Art Unit 3724**